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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,002	03/15/2001	Robert Stanley Arling	10010131-1	4587

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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BRIARCLIFF MANOR, NY 10510

EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

3626

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,002

Applicant(s)

ARLING ET AL.

Examiner

Carolyn M. Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 November 2005 has been entered.
2. This communication is in response to the RCE filed 7 November 2005. Claims 1-22 are pending. Claims 1-15 have been amended.

Claim Rejections - 35 USC § 112

3. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 22, line 2, "the medical characteristic" lacks proper antecedent basis. For purposes of applying prior art this is assumed to be a test value.

Claim Rejections - 35 USC § 101

4. Claims 1-7 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed

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invention must fall into one of the four recognized statutory classes on invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter.

(A) Claims 1-7 appear to be directed toward a report generator. However, it is unclear as to which recognized statutory class of invention the report generator of claims 1-7 is directed. In particular, a report generator is not a process or method as it lacks a series of steps. A report generator is not a machine or system as there is no specific recitation of machine or system components. A report generator is not recognized as a composition of matter.

Claim 23 recites "a computer-readable medium including a set of computer instructions stored on the medium." Under the guidance of recent case law, the requirements of 35 U.S.C. 101 are met when "the practical application of the abstract idea produces a useful, concrete, and tangible result" (State Street Bank & Trust Co. vs. Signature Financial Group, Inc., 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)).

However, the claim, as presently recited, does not appear to have a tangible result.

Data structures or computer programs, in general, that are not claimed as embodied in computer-readable media are descriptive material per se, and are not statutory because they are not capable of causing functional change in a computer.

In particular, it is unclear whether the computer-readable medium, as recited in claim 23, is embodied on a specific readable medium within the technological arts (and thus tangible) or executable by the computer, since it appears the computer-readable

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medium is not limited to any particular structural element. Such claimed data does not define any structural and functional interrelationships between the data and other claimed elements of a computer, which permit the purpose of the data to be realized (see MPEP section 2106 section IV, B, 1, (a) for further guidance). Simply stated, how is the claimed computer-readable medium tangibly embodied within the computer and how is that embodiment structurally related to the computer?

In light of the above, it is respectfully submitted that the claimed invention, although useful and concrete, is not tangible, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-9, 11-14, 15-16, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background of the Invention (pages 1-2 of Applicant's specification) in view of Coli et al. (6,018,713).

(A) As per claims 1, 8, 15, and 23, Applicant's Background of the Invention discloses that "It is known to automate medical report generation through the use of a computer. In the various report automation devices, various medical conditions can be selected

from a list of medical conditions. The medical conditions represent clinical diagnoses and other information relevant to the exam. The medical conditions can also represent the underlying pathology that might be encountered.” (It is noted this disclosure reads on “electronically selecting a medical condition for inclusion in a medical report; see pg. 1, par. 4 of specification). Applicant also discloses that “Another known report generation system feature enables the entry of measurement values into the report generation system such that various measurements pertaining to a patient’s medical condition may be automatically inserted into a report.” (It is noted this disclosure reads on “automatically inserting a measurement corresponding to the selected medical condition when the medical report is generated; see pg. 2, par. 6 of specification).

Thus, the only feature that Applicant’s Background of the Invention fails to disclose is the feature of “the measurement replacing the field.” Coli discloses a plurality of test results obtained through a plurality of types of tests used to make a diagnosis, where the test results are organized in a standardized format in which the test result values are arranged in predetermined fields. (Fig. 11-13, 18, 20, col. 13 line 43 to col. 14 line 67). Coli teaches that the test result values as shown in Fig. 18 and 20 are placed in a field associated with that type of test used to make a particular patient diagnosis (reads on “fields representative of a plurality of medical conditions”) (col. 3 lines 43-52). Coli further teaches a graphically user interface for data input, wherein the reports of test results are generated using software running on client and server computers (see Fig. 11, col. 9 lines 4-60).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Coli within Applicant's Background of the Invention with the motivation of providing reports in an easy-to-understand manner when reporting the results (Coli; col. 2 lines 52-64).

(B) As per claim 16, Coli discloses listing a plurality of defined values associated with the test results (see Fig. 11-13, 18, and 20; col. 13 line 43 to col. 14 line 67).

(C) As per claim 18, Coli discloses measuring the time and date of a test result (col. 14 lines 26-41).

(D) As per claim 19, Coli discloses updating the patient's test results when the report is requested through the automated test equipment interface, wherein the updated test results are directly put into a patient record which is then displayed as a patient report (col. 15 line 30 to col. 16 line 8).

(E) As per claim 20, Applicant's Background of the Invention discloses the medical condition being a clinical diagnosis (par. 4).

(F) As per claims 21-22, Coli discloses the test results being retrieved from a database (col. 14 lines 1-41).

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(G) Claims 2, 4-7, 9, 11-14 repeat the subject matter of claims 15-16 and 17-21, and are therefore rejected for the same reasons as those claims.

7. Claims 3, 10, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Background of the Invention (pages 1-2 of Applicant's specification) in view of Coli et al. (6,018,713) as applied to claims 1, 8, and 15, and further in view of Stoodley (6,611,846).

(A) As per claims 3, 10, and 17, Applicant's Background of the Invention and Coli do not expressly disclose the measurement is replaced with a calculation value derived from one or more measurements.

Stoodley discloses 1) by entering the patient's date of birth, the age of the patient is automatically calculated and entered in the age field, 2) calculating the total number of particular patient data and displaying the total number, and/or 3) graphing a plot of velocities of blood flow rate (cm/sec) within the selected vessels over a course of dates (see Fig. 2d, col. 10 lines 1-10, col. 10 line 66 to col. 11 line 31, col. 17 lines 35-52).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Stoodley within the method taught collectively Coli and Applicant's Background with the motivation of providing reports having analysis in an easy-to-understand manner when reporting the results (Coli; col. 2 lines 52-64).

Response to Arguments

8. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(571) 273-8300 [Official communications]

(571) 273-8300 [After Final communications labeled "Box AF"]

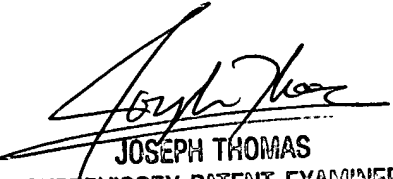
(571) 273-6767 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

November 9, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600